

**REMARKS**

Claims 1-20 are pending in the application.

Claims 1-20 have been rejected.

Claims 1, 3, 5-10, 12-13, 15-17 and 19-20 have been amended, as set forth herein.

Claim 4 has been canceled, without prejudice.

I. **CLAIM OBJECTIONS**

The Claims have been amended to spell out certain acronyms in the original claims, as requested by the Examiner.

II. **REJECTION UNDER 35 U.S.C. § 102**

Claims 1-4 and 7 were rejected under 35 U.S.C. § 102(e) as being anticipated by Hartsell, et al. (US Pat App 2002/0065864). The rejection is respectfully traversed.

A cited prior art reference anticipates the claimed invention under 35 U.S.C. § 102 only if every element of a claimed invention is identically shown in that single reference, arranged as they are in the claims. MPEP § 2131; *In re Bond*, 910 F.2d 831, 832, 15 U.S.P.Q.2d 1566, 1567 (Fed. Cir. 1990). Anticipation is only shown where each and every limitation of the claimed invention is found in a single cited prior art reference. MPEP § 2131; *In re Donohue*, 766 F.2d 531, 534, 226 U.S.P.Q. 619, 621 (Fed. Cir. 1985).

Applicant has amended the claims to more particularly point out and distinctly claim the Applicant's invention. Specifically, independent Claim 1 has been amended to recite "the code comprising priority services capability information defining priority services supported by a mobile switching center (MSC)." Similarly, independent Claims 8 and 15 have been amended to recite "the priority services designation comprising priority service capability information defining priority services supported by a mobile switching center (MSC)."

Though Hartsell generally describes class of services, the reference does not appear to disclose (1) receiving a code that includes priority services capability information defining priority services supported by a mobile switching center (MSC) (Claim 1, as amended), or (2) generating/receiving an Update Location (UL) message having a priority services designation that includes priority service capability information defining priority services supported by a mobile switching center (MSC) (Claims 8 and 15, as amended).

Accordingly, the Applicant respectfully requests the Examiner withdraw the § 102(e) rejection of Claims 1-3 and 7.

### III. REJECTIONS UNDER 35 U.S.C. § 103

Claim 5 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Hartsell, et al. (US Pat App 2002/0065864) in view of Aschir (US Pat App 2002/0071444). Claim 6 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Hartsell, et al. (US Pat App 2002/0065864) in view of Hitzeman (US Pat App 2003/0220115). Claims 8, 11, 14-15 and 18 were rejected under 35

U.S.C. § 103(a) as being unpatentable over Hartsell, et al. (US Pat App 2002/0065864) in view of Haumont, et al. (US 6,955,918). Claims 9, 12, 16 and 19 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Hartsell, et al. (US Pat App 2002/0065864) in view of Haumont, et al. (US 6,955,918) and further in view of Aschir (US Pat App 2002/0071444). Claims 10, 13, 17 and 20 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Hartsell, et al. (US Pat App 2002/0065864) in view of Haumont, et al. (US 6,955,918) and further in view of Hizteman (US Pat App 2003/0220115). The rejections are respectfully traversed.

In *ex parte* examination of patent applications, the Patent Office bears the burden of establishing a *prima facie* case of obviousness. MPEP § 2142; *In re Fritch*, 972 F.2d 1260, 1262, 23 U.S.P.Q.2d 1780, 1783 (Fed. Cir. 1992). The initial burden of establishing a *prima facie* basis to deny patentability to a claimed invention is always upon the Patent Office. MPEP § 2142; *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Piasecki*, 745 F.2d 1468, 1472, 223 U.S.P.Q. 785, 788 (Fed. Cir. 1984). Only when a *prima facie* case of obviousness is established does the burden shift to the applicant to produce evidence of nonobviousness. MPEP § 2142; *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Rijckaert*, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). If the Patent Office does not produce a *prima facie* case of unpatentability, then without more the applicant is entitled to grant of a patent. *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Grabiak*, 769 F.2d 729, 733, 226 U.S.P.Q. 870, 873 (Fed. Cir. 1985).

A *prima facie* case of obviousness is established when the teachings of the prior art itself suggest the claimed subject matter to a person of ordinary skill in the art. *In re Bell*, 991 F.2d 781, 783, 26 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1993). To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed invention and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. MPEP § 2142.

The primary reference for all of the stated 103 rejections is Hartsell. As established above, Hartsell does not disclose, teach or suggest all the elements/features of the Applicant's claims (as amended.). Furthermore, none of the secondary references appear to disclose receiving a code (or UL message) having information therein (priority service capability information) defining priority services supported by a mobile switching center (MSC).

Accordingly, the Applicant respectfully requests withdrawal of the § 103 rejection of Claims 1-3 and 5-20.

IV. CONCLUSION

As a result of the foregoing, the Applicant asserts that the remaining Claims in the Application are in condition for allowance, and respectfully requests an early allowance of such Claims.

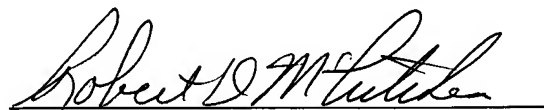
If any issues arise, or if the Examiner has any suggestions for expediting allowance of this Application, the Applicant respectfully invites the Examiner to contact the undersigned at the telephone number indicated below or at *rmccutcheon@munckbutrus.com*.

The Commissioner is hereby authorized to charge any additional fees connected with this communication or credit any overpayment to Davis Munck Deposit Account No. 50-0208.

Respectfully submitted,

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